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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/875,088      | 06/05/2001  | Douglas Fisher       | 01-103              | 7712             |

23843 7590 03/05/2004

HOWARD E LEBOWITZ  
19682 HESPERIAN BLVD  
Suite 208  
HAYWARD, CA 94541

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| EXAMINER |
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WORJLOH, JALATEE

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/875,088

Applicant(s)

FISHER, DOUGLAS

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-26,35 and 36 is/are allowed.
- 6) ☒ Claim(s) 1-20 and 27-34 is/are rejected.
- 7) ☐ Claim(s) 14-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-36 have been examined.

#### *Claim Objections*

2. Claim 27 is objected to because of the following informalities: typographically error, change "anauthetnication" to "an authentication" (see ii). Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,4-7,9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5815665 to Teper et al.

Referring to claims 1 and 5, Teper et al. disclose providing an on-line authentication service (i.e. "online broking service") available o the distributed network, authenticating a plurality of users (i.e. users and SP) to said on-line authentication service using a closed authentications system to produce a plurality of authenticated users (see abstract; col. 6, lines 1-20), connecting a group of at least two of said plurality of authenticated users under persistent mediation of said on-line authentication service, producing a connected group; wherein the on-line service is a persistent authentication and mediation service (see col. 11, lines 13-33).

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Referring to claims 2 and 7, Teper et al. disclose enrolling said users to said on-line authentication service prior to authenticating said users to said on-line authentication service (see col. 6, lines 1 & 2).

Referring to claims 4 and 9, Teper et al. disclose said closed authentication system is a pseudo-PKI system of the type which cryptographically camouflages a user's private key in a software container (see col. 10, lines 13-17). Note. Teper et al. states, "Although a one-way hash algorithm is preferred, it will be recognized that other types of cryptographic algorithms can be used to generate the response message, including public key and private key encryption algorithms"; therefore, a pseudo-PKI system of the type which cryptographically camouflages a user's private key in a software container can also taught by Teper.

Teper et al. disclose providing an on-line authentication service (i.e. "online broking service") available on the distributed network, authenticating a plurality of users (i.e. users and SP) to said on-line authentication service using a closed PKI authentication system to produce a plurality of authenticated users (see abstract; col. 6, lines 1-20), connecting a group of at least two of said plurality of authenticated users under persistent mediation of said on-line authentication service, producing a connected group; wherein the on-line service is a persistent authentication and mediation service (see col. 11, lines 13-33).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al. as applied to claims 1 and 6 respectively above, and further in view of U.S. Patent No. 5812670 to Micali.

Teper et al. disclose a connecting a group of at least two of said plurality of authenticated users (see claim 1 above). Teper et al. do not expressly disclose the persistent mediation of said connected group comprises compiling an audit trail of an interaction of said connected group. Micali discloses compiling an audit trail of an interaction of a connected group (see col. 2, lines 35-47; col. 3, lines 18-21). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Teper et al. to include the step of compiling an audit trail of an interaction for said group. One of ordinary skill in the art would have been motivated to do this because it monitors users transactions, which is necessary in order to reduce future disputes.

7. Claims 11, 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al. in view of Micali.

Teper et al. disclose providing a persistent authentication and mediation service as an on-line service on the distributed network, authenticating enrolled users seeking authentication and mediation service using a closed PKI authentication system, so as to maintain a plurality of authenticated users; mediating the interaction among the at least two users of each of said plurality of groups of connected users after connection, wherein the act of mediating the interaction comprises the acts of providing authentication identity information to the interaction (see abstract, col. 6, lines 1-20), enrolling users seeking enrollment in the persistent

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authentication and mediation service, to produce a plurality of enrolled users (see col. 6, lines 1 and 2), receiving requests from enrolled users for authentication to the persistent authentication and mediation service (see col. 10, lines 44-46), receiving requests from authenticated users to be connected to particular other authenticated user (see col. 9, lines 50-56), connecting groups of at least two authentication and mediation service so that the at least two authenticated users can conduct an interaction (see col. 11, lines 13-33), repeating act (f) to produce a plurality of groups of connected users (see col. 12, lines 14-29). Teper et al. do not expressly disclose directly compiling an audit trail of the interaction and making information from the audit trail available to the at least two users of each group of connected users. Micali discloses compiling an audit trail of the interaction and making information from the audit trail available to the at least two users of each group of connected users (see col. 2, lines 35-47; col. 3, lines 18-21). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Teper et al. to include the step of compiling an audit trail of an interaction for said group. One of ordinary skill in the art would have been motivated to do this because it monitors users transactions, which is necessary in order to reduce future disputes.

Referring to claims 27, and 30-33, Teper et al. disclose a persistent authentication and mediation service site providing a persistent authentication and mediation service, said site connected to the public network, said site comprising a open software platform application providing intelligent interactions said platform application mediating all interactions of said persistent authentication and mediation service site via said public network, an authentication agent application comprising a software pseudo-PKI authentication application operating on said open software platform application, said common authentication agent application comprising

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software which enrolls new businesses users producing enrolled users and authenticates the enrolled users; software application operating on the platform; a multiplicity of user sites operated by the enrolled users, the user sites being connected to the public network, each site operating at least one computer application whereby it may interact with other business users and each site further comprising software which allows interaction with the persistent authentication and mediation service, a software camouflaged private key, and a digital certificate, said digital certificate comprising an encrypted pseudo-public key recognizable to said persistent authentication; wherein at least one authentication application provider is located at a different site than the persistent authentication and mediation service site; where the network is the public Internet; wherein the user sites comprise sites which are chosen from the group consisting of user sites which access the network via a browser operating on a computer, mobile telephonic devices which access the network, world wide web sites, and sites comprising applications without a user interface (see abstract; col. 6, lines 1-20; col. 10, lines 13-18); and a database of authentication information pertaining to the enrolled business users of said persistent authentication and mediation service, the database accessible to the common authentication application (see col. 2, lines 57-67). Teper et al. do not expressly disclose discovery software, collaboration software or an audit agent application operating on said open software platform which logs and monitors interactions mediated by the open software platform, a plurality of audit provider applications accessible by the audit agent application. Micali discloses an audit agent application operating on said open software platform which logs and monitors interactions mediated by the open software platform and a plurality of audit provider applications accessible by the audit agent application; wherein the network is the public Internet (see col. 2, lines 35-47;

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col. 3, lines 18-21). As for the discovery software and collaboration software these are non-functioning descriptive materials. That is, the open software platform application will be able to provide intelligent interactions regardless of the additional software (e.g. discovery and collaboration). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide intelligent interactions without additional software such as discovery and collaboration.

Referring to claims 28 and 29, Teper et al. disclose a plurality of authentication provider applications accessible by the authentication agent application and at least one authentication provider application is located at a different site than the persistent authentication and mediation service site (see abstract, col. 6, lines 1-20).

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al. and Micali as applied to claim 11 above, and further in view of US Patent No. 6404337 to Van Till et al.

Teper et al. disclose distributing software to a user seeking enrollment which enables microprocessor equipped devices operated by the user seeking enrollment to interact with said persistent authentication and mediation service (see abstract), generating a unique private key, and a unique public key for the user seeking enrollment (see col. 1, lines 13-18), containing permanent credentials particular to each of the user seeking enrollment, said credentials



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comprising public permanent credentials and secret permanent credentials (see col. 6, lines 1-13), storing said permanent credentials in a customer database, said customer database being accessible to said persistent authentication whereby the user seeking enrollment becomes one of said multiplicity of enrolled users, and repeating steps (1) through (f) for each applicant seeking enrollment (see col. 2, lines 57-67). As for the step of deciding whether to approve the applicant seeking enrollment, this is an inherent step. Teper et al. do not expressly disclose distributing the unique public key and the unique private key to the user seeking enrollment if the user seeking enrollment is approved. Van Till et al. distributing the unique public key and the unique private key to the user seeking enrollment if the user seeking enrollment is approved (see col. 5, lines 64-67; col. 6, lines 1-10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Teper to include the step of distributing the unique public key and the unique private key to the user seeking enrollment if the user seeking enrollment is approved. One of ordinary skill in the art would have been motivated to do this because it provides means for secure transaction verification.

Referring to claim 13, Teper et al. disclose generating a challenge message from the persistent authentication and mediation service and sending it over the public network to an enrolled user seeking authentication, receiving a response to the challenge from the user seeking authentication, receiving a response to the challenge from the user seeking authentication, said response comprising an encrypted message and the unique public key unique to the enrolled user seeking authentication (see col. 9, lines 50-67; col. 10, lines 1-17); rejecting the user if the decrypted response indicates that the response was not authentic (see col. 11, lines 11-13), repeating steps (a) through (e) for each enrolled user seeking authentication (see col. 6, lines 1

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and 2). As for the steps of verifying the authenticity of the response to the challenge, the act of verifying the authenticity comprising the act of decrypting the response using the public key unique to the enrolled user seeking authentication to produce a decrypted response, authenticating the enrolled user seeking authentication if the decrypted response indicates that the response was authentic, whereby the enrolled user seeking authentication becomes an authenticated user, Teper does not explicitly claims these steps, but indicates that alternative authentication processes including public/private key encryption can be used (see col. 9, lines 50-67; col. 10, lines 1-17).

*Allowable Subject Matter*

9. Claims 14-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (**particularly, the limitations of claim 14**).

10. Claims 22-26, 35 and 36 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
PO Box 1450  
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, V.A., Seventh floor receptionist.

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February 26, 2004

  
**JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**